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Attorney Docket No. H01.2B-9610-US01

### REMARKS

This Amendment is in response to the Final Office Action dated July 30, 2003. Claims 1 – 10 are pending in this application. The Office Action rejects claims 1, 2, 4, 5 and 7 – 10 under 35 USC § 103 over Streit (U.S. Patent No. 5902512), and rejects claims 3 and 6 35 USC § 103 over Streit in view of Weider (U.S. Patent No. 6308929). These rejections are respectfully traversed.

By this Amendment, claims 2 – 10 are amended for clarification purposes. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

#### **Claim Rejections - Streit**

The Office Action rejects, under 35 USC § 103, claims 1, 2, 4, 5 and 7 - 10 over Streit (U.S. Patent No. 5902512). These rejections are respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings to produce the claimed invention. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure (MPEP 2142). The prior art must suggest the desirability of the claimed invention (MPEP 2143.01).

Applicants assert that the Examiner has failed to satisfy any of the basic criteria necessary to establish a *prima facie* case of obviousness. Streit does not disclose or suggest "a punch for a rotary compression press," as recited in independent claim 1. Further, the Examiner has provided absolutely no motivation to modify the teachings of Streit to arrive at the device of claim 1.

Streit discloses a stationary insert which is located in a pocket within an injection molding device. The purpose of the insert is to imprint reference indicia on the product made by the injection molding device (see column 3, lines 14 – 26). During the injection molding process, the insert is stationary, and no parts move to contribute to a compression force.

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The Streit insert 5, which is shown in one embodiment in Fig. 3, is enclosed by a cylindrical housing 10 which is inserted in a corresponding pocket of the injection molding device. This insert 5 includes a plurality of conical rings 20, 21, 22 (Fig. 3). The rings are nested into one another, and a fastener 45 is nested in the inner ring 20. At the outer circumference the rings 20 to 22 accommodate annular washers or retainers 25 in respective grooves 27. The washers 25 cooperate with steps of a stepped bore 15 of the housing 10 and with the lower surface of the conical rings 20 to 22. A double bolted member 40,42 is arranged with a portion 42 threaded into the fastener 45 and with the other portion 40 threaded into a threaded bore 15 of the insert. The threads of the portions 40, 42 are opposed. Between the portions 40, 42 a larger flange portion is disposed which may cooperate with the lower surface of the fastener 45 and of the inner ring 20.

In the position shown in Fig. 3, the rings 20 to 22 which bear indicia on the outer surface 17 are fixed and cannot rotate and cannot move outwardly of the insert. If the fastener 45 is manually rotated with a screwdriver or the like, the fastener 45 will move outwardly, thereby releasing the inner ring 20. By this manual releasing mechanism, the inner ring may be manually rotated relative to the other rings for adjusting a desired portion with the respective indicia. Further outward movement of ring 20 leads to the engagement of its washer 25 with the lower surface of the intermediate ring 21, which may then be lifted. Further movement will also lead to a lifting of the outer ring 22. The outer ring 22 limits the outward movement by engagement of its washer 25 with housing 10 of the insert. When the indicia adjustment is finished, the fastener 45 is manually rotated in opposite direction and tightened so that all rings 20 to 22 can be returned to the position shown in Fig. 3, thus becoming fixed in place. Thus, the Streit device allows for manual removal of the insert and manual adjustment of the reference indicia to be imprinted upon product made by the injection molding device.

Streit in no way discloses or suggests the device of independent claim 1. Streit fails to disclose even the basic structure of "a punch for a rotary compression press, ...at least one guiding bore for the axial guidance of the punch," and "an insert...for compression of material in the die bore." Further, Streit clearly does not disclose or suggest the "insert being biased by a spring toward the front-end face, the insert being adapted to automatically rotate in the end-side bore in a first rotational direction and to be axially moved against the bias of the spring against

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an upper stop by means of a cooperation of threaded spindle and spindle nut, when the insert is pressed into the die bore against the material therein." Nor does Streit disclose or suggest a mechanism for the insert to automatically "rotate back in the reverse rotational direction and to be axially moved against a lower stop axially spaced from the upper stop when the insert is moved out of the die bore," as clearly recited in independent claim 1.

Therefore, Streit fails to disclose, *inter alia*, a displacement between first and second stop means while the insert is biased toward the first stop means. Streit further fails to disclose a rotation of the insert when a compression force is exerted onto the insert. Even further, Streit fails to disclose an automatic back rotation of the insert when the compression force is decreased or removed.

Further, the Streit disclosure is directed towards a device for imprinting reference indicia during the injection molding of material. Applicants assert that a person of ordinary skill in the art would not look to the technology of injection molding when attempting to solve a problem directed to rotary compression pressing. The Streit device performs a clearly different function in a clearly different technology area than that of the punch for a rotary compression press of claim 1. In order to demonstrate art related to a punch according to claim 1, Applicants invite the Examiner to review US Patent No. 6595767, which discloses a rotary compression press. The device of US Patent No. 6595767 solves a similar problem to which the device of claim 1 is directed, but utilizes a different structure and method.

Applicants assert that the disclosure of Streit is so far removed from the claimed invention that the Examiner's reading of the limitations of claim 1 into the Streit disclosure constitutes an impermissible use of hindsight. Obviousness cannot be established by hindsight combination to produce the claimed invention (see *In re Gorman*, 18 USPQ2d 1885 (Fed.Cir.1991)). It is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination.

Further, Applicants suspect that the Examiner, in making the current obviousness rejection, may have relied on the concept of inherency. Inherency may apply when a claimed device is structurally identical to a device in the prior art, even if the proposed claim includes limitations with respect to an intended use that differentiate the claimed device from the prior art, to allow the claim to be rejected under 35 USC §102 as *anticipated* because the prior art device

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could inherently be used as the claimed device. However, consideration of an inherent quality is relevant only to anticipation, not obviousness. *Jones v. Hardy*, 220 USPQ 1021 (Fed. Cir. 1984). Further, with respect to claim 1, as Applicants have repeatedly asserted, the claimed punch for a rotary compression press is not structurally identical to the Streit adjustable date stamp mold insert.

The rejection of claims 1, 2, 4, 5 and 7 - 10 over Streit in the currently outstanding Final Office Action is substantially copied from the Examiner's prior Non-final Office Action dated March 14, 2003. However, as discussed above, the current rejections fail to address a number of limitations added to independent claim 1 in Applicants' previous Amendment filed June 6, 2003.

Applicants respectfully request that the Examiner fully consider all of the limitations of the claims.

Applicants again assert that Streit does not disclose or suggest a rotary compression press as recited in independent claim 1. Further, Applicants assert that the Examiner has provided absolutely no prior art motivation to modify Streit to arrive at claim 1, and as such the cited prior art fails to suggest the desirability of the claimed invention as required under 35 USC §103.

Therefore, Applicants respectfully submit that independent claim 1 is not made obvious in light of Streit. Claims 2, 4, 5 and 7 - 10 depend from independent claim 1 and therefore are not made obvious in light of Streit for at least the reasons discussed above. Accordingly, Applicants respectfully request the withdrawal of the rejections under 35 USC § 103.

#### **Claim Rejections - Weider**

The Office Action also rejects, under 35 USC § 103, claims 3 and 6 over Streit in view of Weider (U.S. Patent No. 6308929). These rejections are respectfully traversed.

Applicants assert that Weider does not disclose or suggest a rotary compression press as recited in claims 3 and 6.

Similarly to Streit, Weider discloses an injection mold insert. Weider does not disclose or suggest "a punch for a rotary compression press, ...at least one guiding bore for the axial guidance of the punch," and "an insert...for compression of material in the die bore." Further, Weider clearly does not disclose or suggest the "insert being biased by a spring toward the front-end face, the insert being adapted to automatically rotate in the end-side bore in a first rotational

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direction and to be axially moved against the bias of the spring against an upper stop by means of a cooperation of threaded spindle and spindle nut, when the insert is pressed into the die bore against the material therein." Nor does Weider disclose or suggest a mechanism for the insert to automatically "rotate back in the reverse rotational direction and to be axially moved against a lower stop axially spaced from the upper stop when the insert is moved out of the die bore," as recited in independent claim 1.

Claims 3 and 6 depend from independent claim 1 and therefore include all of the limitations of claim 1. Therefore, Applicants assert that claims 3 and 6 are not made obvious by Streit in view of Weider. Accordingly, Applicants respectfully request the withdrawal of the rejections under 35 USC § 103.

#### **CONCLUSION**

Based on at least the foregoing remarks, Applicants respectfully submit this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1 - 10 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

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